

REMARKS

Claims 5-17 and 19 are pending in this application. The typographical error in claim 5 has been corrected. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

The Office Action (OA) rejects, under 35 U.S.C. § 102(b), claims 5-11 over Ma et al. (U.S. Patent No. 5,995,500), hereinafter “Ma.” The Office Action also rejects, under 35 U.S.C. § 103, claims 12-17, and 19 over Ma and Larsen (U.S. 2001/0036810). These rejections are respectfully traversed.

Claim 5 is directed to a method for operating a radiotelephone system, the method comprising: at one or more mobile stations of the radiotelephone system, detecting other mobile stations to which radio propagation conditions are sufficiently good; at the one or more mobile stations, communicating information about the detected mobile stations to a base station of the radiotelephone system; at a first mobile station, after the detecting the other mobile stations to which the radio propagation conditions are sufficiently good and after the communicating the information about the detected mobile stations, requesting communication with a second mobile station; and at the base station, if the radio propagation conditions between the first mobile station and the second mobile station are sufficiently good, instructing the first mobile station and the second mobile station to establish direct communication (emphasis ours).

In more detail, it is noted that information concerning the detected mobile stations, which have been detected as having sufficiently good radio propagation conditions with a mobile station, is sent by the mobile station to a base station prior to the mobile station requesting communication with another mobile station. See, for example, FIG 2 and the accompanying description and subsequent FIG. 3 and the accompanying description for support for this amendment. Thus, as set forth in claim 5, a mobile station collects radio propagation information about neighboring mobile stations, determines those mobile stations having good propagation conditions with the mobile station and sends information concerning the determined mobile stations to a base station. When the mobile station wishes to establish communication with another mobile station, the base station can use the received information to determine

whether direct communication is possible. The invention avoids the need to perform measurements once a communication request has been initiated.

Ma does not disclose at one or more mobile stations of the radiotelephone system, detecting other mobile stations to which radio propagation conditions are sufficiently good and at the base station, if the radio propagation conditions between the first mobile station and the second mobile station are sufficiently good, instructing the first mobile station and the second mobile station to establish direct communication.

Stated differently, Claim 5 is quite explicit that one mobile detects directly the usability/quality of a signal from another mobile. In Ma, the RSSI signals that are mentioned are strictly between the base station and the mobile station. See Ma at the end of column 7, line 64, through column 8, line 18. This is clearly different from Applicant's invention, as recited in Claim 5.

Further, claims 5-11 are not anticipated by Ma, because Applicant's claim 5 recites that information concerning the detected mobile stations, which have been detected as having sufficiently good radio propagation conditions with a mobile station, is sent by the mobile station to a base station prior to the mobile station requesting communication with another mobile station. Ma fails to disclose or suggest this feature, in the context of Applicant's invention of claim 5.

Applicant notes that in making the traversal, Applicant relies upon MPEP §2131. This states, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Applicant notes the test is the same for a method or process. Anticipation requires identity between the claimed process and a process of the prior art. The claimed process, including each and every step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel SA v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550 (Fed. Cir. 1995).

For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by one of ordinary skill in the art to which the invention pertains.

See, e.g., Scripps Clinic & Res. Found. V. Genentech, Inc., 927 F.2d 1565 (Fed. Cir. 1991). Said differently, a single prior art reference must properly disclose, teach, or suggest each element of the claimed invention. Moreover, “every element of the claimed invention must literally be present, arranged as in the claim...The identical invention must be shown in as complete detail as is contained in the patent claim.” *See, e.g., Richardson v. Suzuki Motor Company Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Applicant initially notes that Applicant’s invention, as set forth in claim 5, from which claims 6-13 depend, recites that information concerning the detected mobile stations, which have been detected by the mobile station as having sufficiently good radio propagation conditions with a mobile station, is sent by the mobile station to a base station prior to the mobile station requesting communication with another mobile station.

Thus, in accordance with Applicant’s invention as set forth in claim 5, a mobile station collects radio propagation information about other mobile stations that may be nearby, determines whether those mobile stations have sufficiently good propagation conditions with the mobile station, and then sends information concerning the determined mobile stations to a base station prior to initiating contact with another mobile station. When the mobile station wishes to establish communication with another mobile station, the base station can use the received information to determine whether direct communication is possible. Applicant’s invention as recited in claim 5 provides the advantage that there is no need to perform additional measurements once a communication request has been initiated.

Ma fails to teach either the steps of: (1)

For these reasons, Applicant respectfully submits that claims 5-13 are allowable over Ma. Applicant respectfully requests reconsideration of the rejection in light of these comments.

In traversing the 103 (a) rejection, Applicant relies upon MPEP §2141, which sets forth the guidelines for making a proper determination of obviousness as guided by the decision by the Supreme Court in *KSR International Co. v. Tele-flex Inc.* (KSR), 550 U.S. 398 (2007). The Court in *KSR* “...reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). MPEP §2141. The *Graham* analysis requires a determination of the differences between the prior art and an applicant’s invention and the level

of ordinary skill in the pertinent art. *Id.* Where there are differences, an Office Action “...must explain why the difference(s) would have been obvious to one of ordinary skill in the art.” *Id.* Specifically, there must be a “...clear articulation of the reason(s) why the claimed invention would have been obvious.” *Id.*

In making the case for obviousness, the Examiner has the burden of establishing the case in a well-reasoned and articulate way. “To facilitate review, this analysis should be made explicit.” *KSR* at 412, citing *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*

This burden exists because “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR* at 412. Where an invention is contended to be obvious based upon a combination of references, one should be able to identify particular reasons that would have prompted one of ordinary skill in the art to combine the prior art elements. *See KSR* at 412-413. The requirement prevents the use of “...the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1371-72 (Fed Cir. 2000) (quoting *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999)). “When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper.” *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

Applicant initially notes that independent claims 14 and 17 each recite limitations similar to those set forth in claim 5. Specifically, the determination of radio propagation conditions, and transmission of information to a base station prior to attempted communication with another mobile device. Thus, Applicant’s comments regarding the shortcomings and distinctions of Ma, are incorporated herein.

As set forth above, Ma fails to teach determining whether radio propagation conditions are sufficiently good in a mobile station. Further, Ma fails to teach determining anything in a mobile station prior to the mobile station attempting communication with another mobile station.

Further, Ma fails to teach transmission of information about detected mobile stations to a remote base station prior to the mobile station attempting communication with another mobile station.

Applicant respectfully notes that the addition of Larson, does nothing to correct the deficiencies of Ma. Therefore the combination of Ma and Larsen fails to disclose Applicant's invention in claims 12-17 and 19.

For these reasons, Applicant respectfully submits that the rejection to claims 12-17 and 19 has been overcome.

Therefore, Applicant respectfully submits that independent claims 5, 14, and 17 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

CONCLUSION

Based on the foregoing amendments and remarks, Applicant respectfully submits this application is in condition for allowance. Favorable consideration and prompt allowance of claims 5-17 and 19 are earnestly solicited.

The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,

/Gary J. Cunningham/

Gary J. Cunningham
Attorney for Applicant
Registration No. 33,488

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Phone No. (708) 525-4666
Fax No. (847) 523-2350

Please send correspondence to:
Motorola, Inc.
Intellectual Property
600 North U.S. Highway 45
Libertyville, IL 60048